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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/658,864 | 09/09/2003 | Roger M. Snow | PA0912.ap.US | 5191 |

75035 7590 06/02/2011

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| EXAMINER | |
|---|---|
| LAYNO, BENJAMIN | |
| ART UNIT | PAPER NUMBER |
| 3711 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/02/2011 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/658,864 | SNOW, ROGER M. | |
| | Examiner | Art Unit | |
| | BENJAMIN LAYNO | 3711 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

This case has been reopened in light of the **Bilski vs. Kappos** Supreme Court decision.

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

### *Machine or Transformation Test*

For **a process (method) claim** to be statutory subject matter, the process must:

(1) be tied to another statutory class (such as a particular **machine or apparatus**), or

(2) provide **transformation** of the underlying subject matter (such as an article or materials) to a different state or thing.

Process claims tied to a **machine or apparatus** must positively recite the other statutory class (the **machine or apparatus**) to which it is tied, for example by identifying the machine that accomplishes the method steps.

Process claims providing **transformation** must positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

If the claimed method is determined to be a statutory subject matter eligible process, then it must be determined whether the claimed invention falls within a judicial exception (law of nature, natural phenomena or abstract idea). If the claimed judicial exception is practically applied, then the claimed invention is statutory. Practical application can be realized in one of two ways:

(1) Does the use of the particular **machine or apparatus** impose a meaningful limit on the claim's scope? Does use of the **machine or apparatus** involve more than insignificant extra-solution activity?

(2) Does the **transformation** impose a meaningful limit on the claim's scope? Does the **transformation** involve more than insignificant extra-solution activity?

See ***In re Bilski*,** 545 F.3d 943, 88 USPQd 1385 (Fed. Cir. 2008), and see MPEP 2106, subsections IV.C.2.

**The claimed invention does not recite a sufficient tie to a machine or apparatus.** The machine or apparatus should implement the process (method steps), and not merely be an object upon which the process operates. The claims should be clear as to how the machine or apparatus implements the process, rather than simply stating "a machine implemented process". The claimed apparatus of "cards" **is merely an object upon which the process (method steps) operates, and does not by itself implement the process (method steps).** The claimed steps of "a player making a wager …..", "placing an optional side bet bonus wager…..", "a first number of cards are dealt to a bonus hand position", "a second number of cards are dealt to the player", etc.

**do not inherently require the use of a specific machine to perform the steps.** The machine or apparatus limitations should make clear that the use of the machine or apparatus in the claimed process **imposes a meaningful limit** on the claim's scope, and does use a machine involving **more than insignificant extra-solution activity.**

Also, **there is no transformation in these method claims**. The dealing of cards does not transform the "cards" into a different state or thing, the dealing only moves the "cards" from one place to another, the cards remain physically the same and do not transform into a different cards.

***Abstract Idea***

In view of the US Supreme Court in ***Bilski v. Kappos***, 130 S. Ct. 3218, 3225 (2010), the Supreme Court indicated that the machine-or-transformation test is "not the sole test for patent eligibility", but that it may be a "**useful and important clue or investigative tool**" for deciding whether an invention is a patent eligible process under 35 USC 101. In this case, the facts that no particular machine is required to perform the claimed method steps, nor do the steps result in any transformation of a particular article, are indicators that Applicant's are **attempting to patent an abstract idea**. None of the steps are performed by a machine, but rather are performed by a human being. Dealing cards does not transform the "cards" to a different state or thing. It is the same "cards", just arguably cards spread out over a greater area.

Card games traditionally involve the use of a physical cards dealt to a player or players **within a set of predefined rules**. Wagering may or may not occur in typical

card games. Those games that do involve wagering follow a clear **set of guidelines or rules** involving the wagering. Applicant's claimed method, while arguably reciting a number of physical steps of dealing cards is viewed here as **an attempt to claim a new set of rules for playing a card game.** In this Examiner's opinion, **a set of rules qualifies as an abstract idea**. Therefore, the Examiner takes the position that Applicant's claimed method, although couched in terms of a few actual physical steps, is a clear **attempt to claim an abstract idea in the form of a new set of rules for playing a card game.** Since the claimed method requires no machine implementation, requires no transformation of a particular article and is seen as an **attempt to receive patent protection for an abstract idea in the form of a new set of rules,** the Examiner maintains that the claimed method is **NOT patent eligible**.

It is noted here that several factors weighing toward and against patent eligibility have been analyzed by the Examiner, including but not limited to the machine and transformation factors and the abstract idea or general concept factors discussed above. See the Federal Register notice entitled **"Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos (Fed. Reg. Vol. 75, No. 143/Tuesday, July 27, 2010/Notices)** for a complete list of factors that were considered by the Examiner in the above analysis. Specifically, the lack of implementation by a particular machine or the transformation of a particular article and the apparent **attempt to claim an abstract idea in the form of a new set of rules** are all factors that **weigh against eligibility**. The fact that the claims may be more than a mere statement of a concept in that an actual method of playing the game is claimed

versus just a new set of rules may be a factor weighing towards patent eligibility. However, in this case the factors weighing towards eligibility are not given much weight since the use of the concept, as expressed in the method, would effectively grant a monopoly over the concept. It is this Examiner's opinion that the factors in this case weighing against patent eligibility **far outweigh** the factors weighing toward patent eligibility.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN LAYNO whose telephone number is (571)272-4424. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571)272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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